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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/918,509	08/01/2001	Kazuhiko Hayashi	Q65676	3298

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SUGHRUE, MION, ZINN, MACPEAK & SEAS  
2100 Pennsylvania Avenue, N.W.  
Washington, DC 20037

EXAMINER

SWEARINGEN, JEFFREY R

ART UNIT PAPER NUMBER

2145

DATE MAILED: 12/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/918,509

Applicant(s)

HAYASHI, KAZUHIKO

Examiner

Jeffrey R. Swearingen

Art Unit

2145

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 15 September 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-4, 6-20, 22-27 and 29-32 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4, 6-20, 22-27 and 29-32 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>20061011</u> . | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 9/15/2006 has been entered.

### ***Response to Arguments***

2. Applicant's arguments with respect to claims 1-4, 6-20, 22-27, and 29-32 have been considered but are moot in view of the new ground(s) of rejection.

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 9-10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Applicant has giving inadequate information to determine what a *primal storage medium* entails.

### ***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

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6. Claims 1-4, 6-20, 22-27 and 29-32 are rejected under 35 U.S.C. 102(e) as being anticipated by Sitnik (US 6,300,880 B1).

7. In regard to claims 1 and 17, Sitnik disclosed:

*the information storage and playback device comprises: means for storing each of a plurality of partial information of a plurality of delivery information beforehand; means for choosing one of the partial information from the plurality of the stored partial information and reproducing the chosen partial information; and means for giving notice of information that the one of the partial information has been chosen from the plurality of the delivery information to the information delivery device just as reproduction of the chosen partial information starts; [column 7, lines 5-21]*

*the information delivery device comprises means for transmitting remaining information of the partial information, which has been chosen to be reproduced and has been notified by the information storage and playback device, to the information storage and playback device just as reproduction of the partial information of the plurality of the delivery information finishes at the information storage and playback device; [column 8, line 1-45]*

*the information storage and playback device includes a means for reproducing the remaining information of the partial information transmitted from the information delivery device; [column 8, lines 1-45] and*

*the partial information of the delivery information, which is transmitted from the information delivery device to the information storage and playback device through the information communicating means and is received and stored in the information storage and playback device, is renewed, based on records of past utilization of the partial information, when necessary. [column 8, lines 1-45]*

8. In regard to claims 2 and 18, Sitnik disclosed:

*the information storage and playback device comprises: means for storing each of a plurality of partial information of a plurality of delivery information beforehand; means for choosing one of the partial information from the plurality of the stored partial information and reproducing the chosen partial information; and means for giving notice of information that the one of the partial information has been chosen from the plurality of the delivery information to the information delivery device just as reproduction of the chosen partial information starts; [column 7, lines 5-21]*

*the information delivery device includes a means of transmitting remaining information of the partial information which has been chosen to be reproduced at the information storage and playback device to the information storage and playback device while the information storage and playback device is reproducing the partial information; [column 8, lines 1-45]*

*the information storage and playback device comprises means for storing the remaining information of the partial information which has been chosen to be reproduced at the information storage and delivery device, and reproducing the stored remaining information of the partial information which has been chosen to be reproduced at the information storage and playback device just as reproduction of the partial information finishes; [column 8, lines 46-61] and*

*at least a portion of the plurality of partial information is stored in the means for storing without a user request prior to use of the information delivery system by a user. [column 8, lines 6-9]*

9. In regard to claims 3-4, 19-20, Sitnik disclosed:

*connecting a storage medium, in which the partial information of the delivery information is set up by the information delivery device beforehand, to the information storage and playback device, or transmitting the partial information of the delivery information which is set up by the information delivery device beforehand from the information delivery device to the information storage and playback device through the information communicating means and storing the*

*transmitted partial information of the delivery information in a storage medium by the information storage and playback device;*

*transmitting partial information of delivery information, which belongs to an information group chosen to be delivered by the information storage and playback device beforehand, from the information delivery device to the information storage and playback device through the information connecting means, and storing the transmitted partial information of the delivery information which belongs to the information group in a storage medium by the information storage and playback device;*

*transmitting partial information of delivery information, which belongs to one of information groups prioritized and sorted out according to a past record of a user of the information storage and playback device, from the information delivery device to the information storage and playback device through the information communicating means, and storing the transmitted partial information of the delivery information, which belongs to one of the information groups prioritized and sorted out according to the past record of the user of the information storage and playback device, in a storage medium by the information storage and playback device; or*

*transmitting partial information of delivery information, which belongs to one of information groups prioritized and sorted out according to past records of a plurality of users of the information storage and playback devices, from the information delivery device to the information storage and playback device through the information communicating means, and storing the transmitted partial information of the delivery information, which belongs to one of the information groups prioritized and sorted out according to the past records of the plurality of the users of the information storage and playback devices, in a storage medium by the information storage and playback device.*

[column 7, lines 21-60]

10. In regard to claims 6 and 22, Sitnik disclosed:

*the partial information of the delivery information, which is transmitted from the information delivery device to the information storage and playback device through the information communicating means and is received and stored in the information storage and playback device, is renewed when necessary; [column 8, lines 40-45] and*

*the means for storing the partial information of the delivery information in the information storage and playback device before hand is installed by:*

*connecting a storage medium, in which the partial information of the delivery information is set up by the information delivery device beforehand, to the information storage and playback device, or transmitting the partial information of the delivery information which is set up by the information delivery device beforehand from the information delivery device to the information storage and playback device through the information communicating means and storing the transmitted partial information of the delivery information in a storage medium by the information storage and playback device;*

*transmitting partial information of delivery information, which belongs to an information group chosen to be delivered by the information storage and playback device beforehand, from the information delivery device to the information storage and playback device through the information connecting means, and storing the transmitted partial information of the delivery information which belongs to the information group in a storage medium by the information storage and playback device;*

*transmitting partial information of delivery information, which belongs to one of information groups prioritized and sorted out according to a past record of a user of the information storage and playback device, from the information delivery device to the information storage and playback device through the information communicating means, and storing the transmitted partial information of the delivery information, which belongs to one of the information groups prioritized and sorted out according to the past record of the user of the information storage and playback device, in a storage medium by the information storage and playback device; or*

*transmitting partial information of delivery information, which belongs to one of information groups prioritized and sorted out according to past records of a plurality of users of the information storage and playback devices, from the information delivery device to the information storage and playback device through the information communicating means, and storing the transmitted partial information of the delivery information, which belongs to one of the information groups prioritized and sorted out according to the past records of the plurality of the users of the information storage and playback devices, in a storage medium by the information storage and playback device.*

[column 7, lines 21-60]

11. In regard to claims 7-8, Sitnik disclosed:

*the information storage and playback device, which includes a plurality of storage mediums for storing information, stores the partial information of the delivery information in a primary storage medium, and stores the partial information of the delivery information and remaining information of the delivery information transmitted from the information delivery device in one of the other storage mediums different from the primary storage medium. [column 8, lines 29-45]*

12. In regard to claims 9-10, Sitnik disclosed:

*the information storage and playback device, which includes a plurality of storage mediums for storing information, stores the partial information of the delivery information in a primary storage medium, and stores the partial information of the delivery information and remaining information of the delivery information transmitted from the information delivery device in one of the other storage mediums different from the primary storage medium; [column 8, lines 29-45] and*

*the information delivery system employs at least one selected from a removable disk, an optical disc, a phase change optical disc, and a tape medium as a storage medium different from the primal storage medium. [column 8, lines 31-33]*

13. In regard to claims 11-12, Sitnik disclosed:



*the information communicating means comprises at least one of a communicating means for communicating by a satellite, a communicating means for communicating by a public phone line, and a communicating means for communicating by the Internet. [column 7, lines 54-60]*

14. In regard to claims 13-14, Sitnik disclosed:

*the delivery information includes image information, moving picture information, or voice information.*

15. In regard to claims 15-16, Sitnik disclosed:

*the delivery information includes image information, moving picture information, or voice information; and*

*the delivery information includes compressed data information.*

16. In regard to claim 23, Sitnik disclosed:

*an information user making use of the information storage and playback device receives image, reflection or voice information from the information delivery device through the information communicating means; [column 8, lines 17-24] and*

*an information provider, who delivers the image, reflection or voice information to the information user by employing the information delivery device, accounts for use of the image, reflection or voice information by the information user, the accounting including cost information attributable to the information user. [column 8, line 21]*

17. In regard to claims 24-25, Sitnik disclosed:

*in parallel with a start of reproducing partial information of delivery information;*

*after a prescribed period of time from a start of reproducing the partial information of the delivery information; or*

*after reproducing a prescribed amount of the partial information of the delivery information from a start of reproducing the partial information of the delivery information.*

*[column 8, line 21]*

*Note: Claims 24 and 25 are exactly identical.*

18. In regard to claim 26, Sitnik disclosed:

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*in parallel with a finish of reproducing remaining information of delivery information; or  
after a prescribed time of a finish of reproducing the remaining information of the delivery  
information. [column 8, line 21]*

19. In regard to claim 27, Sitnik disclosed:

*in parallel with a start of transmitting remaining information of delivery information;  
after a prescribed time of a start of transmitting the remaining information of the delivery  
information; or  
after transmitting a prescribed amount of the delivery information from a start of  
transmitting the remaining information of the delivery information. [column 8, line 21]*

20. Claims 29 and 30 fulfill the claim limitations of claims 1, 23, and 24.

21. Claims 31 and 32 fulfill the claim limitations of claims 2, 23, and 26.

### **Conclusion**

22. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

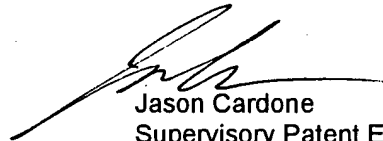
Milsted et al.	US 6,345,256 B1
Dorak, Jr.	US 6,389,403 B1
Gruse et al.	US 6,389,538 B1
Hurtado et al.	US 6,418,421 B1
Guheen et al.	US 6,519,571 B1
Spagna et al.	US 6,587,837 B1
Marconcini et al.	US 6,834,110 B1

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey R. Swearingen whose telephone number is (571) 272-3921. The examiner can normally be reached on M-F 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jason Cardone can be reached on 571-272-3933. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Jason Cardone  
Supervisory Patent Examiner  
Art Unit 2145